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On

12/18/98

TOWNSEND and TOWNSEND and CREW LLP

By:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

GRAY et al.

Application No.: 08/892,695

Filed: July 15, 1997

For: GENES FROM THE 20Q13
AMPLICON AND THEIR USES



PATENT
Attorney Docket No.: 23070-689-3
Client Reference No.: 96-185-4

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Examiner: Unger, S.

Art Unit: 1642

**RESPONSE TO RESTRICTION
REQUIREMENT**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The following is offered in response to the Office Action mailed November 18, 1998. Reconsideration of the application is respectfully requested.

REMARKS

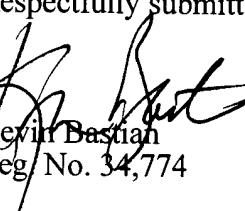
Applicants note with appreciation that the restriction requirements of the Office Action mailed May 27, 1998 have been withdrawn, presumably in response to the traversal in applicants response mailed August 26, 1998. In response to the present restriction, applicants hereby elect with traverse to prosecute the claims of Group II (claims 26-41), directed to methods of screening for neoplastic cells and detecting mutations using nucleic acid probes of the invention. In response to the species election, applicants elect sequences that hybridize to SEQ ID NO:9. Applicants note, however, that SEQ ID Nos 9 and 10 are related in that SEQ

ID NO:9 is the genomic sequence of ZABC1 and SEQ ID NO:10 is the open reading frame for that gene. Thus, it is respectfully requested that these two species be examined together.

According to the MPEP, where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct inventions. *See*, the MPEP at 803.01. In establishing that an “undue burden” would exist for co-examination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. To show undue burden resulting from searching difficulties, the Examiner must show that the restricted groups have a separate classification, acquired a separate status in the art, or that searching would require different fields of search (MPEP at § 808.02). Applicants submit that no undue burden exists in examining all the claims of the present application and therefore respectfully request that the restriction should be withdrawn.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (415) 576-0200.

Respectfully submitted,


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